

REMARKS

Claims 42-44, 46-48, 51-53, 56-73, 75-81, 84, 86-90, and 93-98 are pending. Claims 42, 46-48, 88, and 93-95 are currently amended. Claims 1-41, 45, 49-50, 54-55, 74, 82-83, 85 and 91-92 are canceled. Claim 98 is new. No new matter has been introduced by way of this amendment. The fee for the appropriate extension of time is included herewith.

With regard to claims 42-43, 46-73, 75-81 and 84-85, Applicants previously elected species A, electrospray. With regard to claims 42-69, 73, 75-81 and 84-85, Applicants previously elected Species B, sugars. Claim 70 is within the scope of claim 42 and was unelected. Thus, claim 70 has not been examined. In the event claim 42 is determined to be allowable, Applicants respectfully request that claim 70 be examined for its full scope.

The Examiner objected to the form of claim 85. The Examiner's objection appears to be based on a scanning error at the Patent Office. Claim 85 has been canceled. New claim 98 has been added to cover the subject matter of claim 85.

The Examiner rejected claims 42-48, 51-53, 56-69, 71-73, 75-81 and 84-97 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the Examiner's rejections. Nevertheless, Applicants have amended independent claim 42 to include the limitations of claim 49, as suggested by the Examiner. Applicants have similarly amended independent claims 88, 93 and 95. Applicants also have addressed the Examiner's concerns regarding "passing a portion of" in claim 88. Claims 43-44, 46-48, 51-53, 56-69, 71-73, 75-81, 84, 86-87, and new claim 98 depend from claim 42. Claims 89-90 depend from claim 88. Claim 94 depends from claim 93. Claims 96 and 97 depend from claim 95. Claims 45, 49, 85 and 91-92 have been canceled. Accordingly, Applicants respectfully submit that claims 42-44, 46-48, 51-53, 56-69, 71-73, 75-81, 84, 86-90, and 93-98 comply with the written description requirement.

The Examiner rejected claim 45 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. While Applicants respectfully traverse the Examiner's rejection, claim 45 has been canceled.

The Examiner rejected claims 93-94 and 97 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants respectfully traverse the Examiner's rejections. The Examiner objected to the term "pure" to describe molecules. Independent claim 93 has been amended to clarify which molecules. Accordingly, Applicants submit that claims 93-94 and 97 are sufficiently definite.

The Examiner rejected claims 42-43, 46, 56-57, 68, 77, 79-80 and 86 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,645,897 issued to Andra. Similarly, the Examiner rejected claims 47-48, 51, 52, 58, 61-64, 75-76, 78, 87 and 93-96 under 35 U.S.C. § 103(a) as rendered obvious by Andra. Applicants respectfully traverse the Examiner's rejections. Applicants have nevertheless amended independent claims 42, 93 and 95 to recite, "solvating the molecules in a solvent; ionizing the molecules and solvent; introducing the molecules and solvent into the vacuum system; separating the ionized molecules from the ionized solvent" (or similar language). Andra does not teach suggest or motivate separating the ionized molecules from the ionized solvent, as recited. Claims 43, 46, 56-57, 68, 77, 79-80 and 86 depend from claim 42. Claim 94 depends from claim 93 and claim 96 depends from claim 95. Accordingly, Applicants respectfully submit that claims 42-43, 46, 56-57, 68, 77, 79-80, 86, and 93-96 are not anticipated by or rendered obvious by Andra.

The Examiner rejected claims 42, 46, 56, 61, 67 and 80 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,374,613 issued to Noda, et al., or in the alternative under 35 U.S.C. § 103(a) as rendered obvious by Noda. Applicants respectfully traverse the Examiner's rejections. Nevertheless, Applicant has amended independent claim 42 to recite, "solvating the molecules in a solvent; ionizing the molecules and solvent; introducing the molecules and solvent into the vacuum system; separating the ionized molecules from the ionized solvent." Noda does not teach, suggest or motivate separating the ionized molecules from the ionized solvent, as recited. Accordingly, claims 42, 46, 56, 61, 67 and 80 are not anticipated by or rendered obvious by Noda.

The Examiner rejected claims 42-43, 45-49, 51-53, 56-65 (there is a typographical error in the Office Action), 67-69, 71-73, 75-81, 84-87 and 93-97 under 35 U.S.C. § 103(a) as rendered obvious by U.S. Patent No. 5,944,753 issued to Galin, et al., in view of U.S. Patent No. 6,350,609 issued to Morozov. Applicants respectfully traverse the Examiner's rejections.

As an initial matter, Galin is not an appropriate primary reference. Galin does not teach, suggest or motivate separation from the solvent in teaching coating by various methods, including spray coating, in combination with surface preparation by plasma treatment. Applicants previously argued that the Examiner did not point to any suggestion in either Galin or Morozov for combining plasma treating of an object in a vacuum system with depositing molecules by directing a beam of molecules in an ionized state at the object in the vacuum system as claimed. See MPEP § 2143.01. "The mere fact that references can be combined or modified does not render the claimed combination obvious unless the prior art also suggests the desirability of the combination." *Id.* (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990)). Applicants argued the Examiner was instead using hindsight to argue that the improved efficiency of the claimed process renders it obvious. Applicants also argued that both Galin and Morozov teach away from the claimed method. The Examiner points to column 16 of Morozov, which mentions that faster drying protects biomolecules, and column 18, which mentions that different deposition environments may be used. Neither column 16 nor column 18 teach, suggest or motivate combining plasma treating of an object in a vacuum system with depositing molecules by directing a beam of molecules in an ionized state at the object in the vacuum system as claimed. The Examiner has not pointed to any portion of Galin or Morozov that teaches, suggests or motivates the claimed combinations. Claims 45 and 49 have been canceled. Accordingly, Applicants respectfully submit that claims 42-43, 46-48, 51-53, 56-65, 67-69, 71-73, 75-81, 84, 86-87 and 93-97 (as well as new claim 98) are not rendered obvious by Galin in view of Morozov.

The Examiner rejected claims 42-43, 45-49, 51-53, 56-69, 71-73, 75-81 and 84-97 under 35 U.S.C. § 103(a) as rendered obvious over U.S. Patent No. 5,849,368 issued to Hostettler in view of Morozov. Applicants respectfully traverse the Examiner's rejections.

The Examiner relies on the same portions of Morozov, discussed above, and which do not teach suggest or motivate combining plasma treating of an object in a vacuum system with depositing molecules by directing a beam of molecules in an ionized state at the object in the vacuum system as claimed. The Examiner has not pointed to any portion of Hostettler or Morozov that teaches, suggests or motivates the claimed combinations.

In addition, the Examiner failed to address Applicants' other arguments. The Examiner did not address Applicants' argument that modifying Hostettler would change the principles of operation of Hostettler, which includes polymerization of molecules in a plasma. Modifying the principals of operation of a reference means that the modification is not obvious. See MPEP 2143.01. Further, the Examiner did not address Applicants' argument that, with regard to claim 88 and claims 89-90 that depend from claim 88, claim 88 recites, "depositing the molecules on the surface of the first portion of the object in a second treatment chamber of the vacuum system by directing a substantially solvent-free beam of the molecules in an ionized state at the surface." The Examiner does not contend it would be obvious to employ first and second treatment chambers, as also recited in claim 88. Claims 45, 49 and 91-92 have been canceled. Accordingly, Applicants respectfully submit that claims 42-43, 46-48, 51-53, 56-69, 71-73, 75-81, 84, 86-90 and 93-97 (as well as new claim 98) are not rendered obvious by Hostettler in view of Morozov.

The Examiner rejected claims 42-49, 51-53, 56-69, 71-73 and 84-97 under 35 U.S.C. § 103(a) as rendered obvious by U.S. Patent No. 5,824,049 issued to Ragheb in view of Morozov. Applicants respectfully traverse the Examiner's rejections. As previously argued by Applicants, Ragheb discloses a process for covering a bioactive material with a porous layer. Ragheb provides no details regarding the process for depositing the bioactive material, other than to tersely suggest plasma treatment, vapor-phase deposition, spraying, and dipping. When discussing spraying and dipping, Ragheb provides as an example that: "a polymer solution may be applied to the stent and the solvent allowed to evaporate." Ragheb, Column 12, lines 30-36. Ragheb is not any more instructive than Hostettler and, like Hostettler, teaches away from the claimed methods. Moreover, Ragheb is in a different class than the elected claims, and in a

different class than Morozov. Thus, Ragheb is not an appropriate primary reference. Morozov teaches away from the use of substantially solvent-free deposition of molecules.


Further, the Examiner points to no portion of Ragheb or Morozov that provides the motivation to combine plasma treating of an object in a vacuum system with depositing molecules by directing a beam of molecules in an ionized state at the object in the vacuum system as claimed. The Examiner points to column 17, lines 45-47 of Ragheb. Electrostatic deposition of a dry powder is not the same thing as electrospray. The portions of Morozov upon which the Examiner relies do not teach, suggest or motivate the claimed combinations for the reasons set forth above. Moreover, with regard to claims 88 and 89-90 that depend from claim 88, the Examiner does not contend it would be obvious to employ first and second treatment chambers, as recited in claim 88. Claims 45, 49, 85 and 90-91 have been canceled. Accordingly, Applicants respectfully submit that claims 42-44, 46-48, 51-53, 56-69, 71-73, 75-81, 84, 86-90, and 93-97 (as well as new claim 98) are not rendered obvious by Ragheb, et al. in view of Morozov.

Therefore, for these reasons and others, all of Applicants' pending claims are in a condition for allowance. In the event the Examiner disagrees or finds minor informalities, Applicant respectfully requests a telephone interview to discuss the Examiner's issues and to expeditiously resolve prosecution of this application. Applicants previously requested a telephone conference, but the Examiner was unable to timely schedule a conference, as noted by the Examiner. Accompanying this Amendment is Applicants' Second Request for Telephone Interview in the event the Examiner does not agree that the claims are allowable over the cited references.

Application No. 10/081,990
Reply to Office Action dated July 29, 2005

In closing, Applicant respectfully requests the Examiner to enter these amendments and to reconsider this application and its early allowance. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC



Timothy L. Boller
Registration No. 47,435

TLB:rr

Enclosures:

Postcard

Second Applicant Initiated Interview Request Form

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

678512_3.DOC